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PATENT
Customer No. 22,852
Attorney Docket No. 05725.1226-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
Vincent DE LAFORCADE et al.) Group Art Unit: 3732
Application No.: 10/619,612) Examiner: Robyn A. DOAN
Filed: July 16, 2003)
For: APPLICATOR NOZZLE AND) Confirmation No.: 6532
APPLICATOR ASSEMBLY)
INCORPORATING SUCH A)
NOZZLE)

MAIL STOP AMENDMENT

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

RESPONSE TO OFFICE ACTION

In response to the Office Action dated October 6, 2006, Applicants respectfully request that the Patent Office reconsider the present application and withdraw all of the outstanding claim rejections for the reasons explained below.

Claims 1-110 are pending in this application, with claims 1, 24, 39, 62, 84, 91, and 105 being independent claims. Of those pending claims, claims 24-38 have been withdrawn from consideration as being allegedly drawn to a non-elected invention. No claim has been amended or added.

In the Office Action, claims 1, 2, 4-6, 9-23, 39, 40, 42-44, 47-63, 65, and 68-110 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No.

3,101,086 to Di Vito (“Di Vito”) in view of U.S. Patent No. 1,686,936 to Simpson (“Simpson”). Applicants respectfully traverse this rejection.

Independent claim 1 is directed to an applicator nozzle, comprising, among other things, “an arrangement of at least two teeth ..., at least one of the teeth of the arrangement defining a channel being configured to be placed in flow communication with product contained in [a] receptacle, the channel opening on an exterior of the at least one tooth via at least one outlet aperture facing substantially in a direction of at least one adjacent tooth.” Claims 39 and 62 include similar recitations.

Independent claim 84 is directed to an applicator nozzle comprising, among other things, “a plurality of teeth, at least one of the teeth defining a channel,” “at least one outlet aperture in flow communication with the channel, the outlet aperture opening to an exterior of the tooth on an external lateral surface of the at least one tooth,” and “at least one groove ... extending from the outlet aperture ..., wherein the at least one groove faces an adjacent tooth.”

Independent claim 91 is directed to an applicator nozzle comprising, among other things, “at least two teeth arranged in at least one row, at least one tooth of the row having at least one outlet aperture configured to permit product to flow therethrough for application to a surface, ... wherein the outlet aperture faces in a direction of an adjacent tooth.”

Independent claim 101 is directed to an applicator nozzle comprising, among other things, “a row of teeth ... comprising: at least one tooth defining a channel configured to allow product to flow therethrough, the channel opening on an exterior of the tooth via at least one outlet aperture facing in a direction of an adjacent tooth.”

As detailed below, Di Vito and Simpson, taken either alone or in combination, do not teach or otherwise suggest the subject matter of each of independent claims 1, 39, 62, 84, 91, and 101.

Di Vito discloses a combined dispenser and comb device comprising a flask 10 and a hollow comb 20 engageable with a neck 16 of flask 10. Comb 20 includes solid or imperforated teeth 22 interspersed with hollow open-ended teeth 24, as shown in Figs. 1 and 2.

Simpson discloses a fountain comb having a container 10 and teeth 18 extending from container 10. Teeth 18 include tubular openings 17 extending from container 10 and, at their lower ends, form spoon-shaped or U-shaped cross-section, defining channels 19. As best shown in Figs. 1 and 3, channels 19 are open at their front side. See also page 2, lines 19-21, of Simpson.

As is abundantly clear, neither Di Vito nor Simpson teaches or suggests, among other things, “at least one outlet aperture facing substantially in a direction of at least one adjacent tooth,” as recited in independent claim 1 (claims 39 and 62 include similar recitations), “at least one groove [facing] an adjacent tooth,” as recited in independent claim 84, “the outlet aperture [facing] in a direction of an adjacent tooth,” as recited in independent claim 91, and “at least one outlet aperture facing in a direction of an adjacent tooth,” as recited in independent claim 101.

While acknowledging these deficiencies of Di Vito and Simpson, the Office Action merely cites In re Japikse, 181 F.2d 1019, 86 USPQ 70 (CCPA 1950), and alleges that “it would have been obvious ... to position the outlet aperture of Simpson facing substantially in a direction of at least one adjacent tooth, since it has been held that

rearranging location of parts of an invention involves only routine skill in the art."

Applicants respectfully submit that the Office Action's mere reliance on the Japikse case to assert, without any factual basis, obviousness of a missing element is clearly erroneous.

The Examiner has the initial burden of presenting a *prima facie* case of unpatentability. To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), three basic criteria must be met. First, the prior art references when combined must teach or suggest all the claim elements. Second, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references or to combine reference teachings. Finally, there must be a reasonable expectation of success.

M.P.E.P. § 2143.

Completely ignoring these basic criteria for establishing a *prima facie* case, the Office Action merely relies on the Japikse case for a general proposition that "rearranging location of parts of an invention involves only routine skill in the art." Applicants' review of the case, however, reveals no such generalized proposition or rule of law. On the contrary, the Board of Patent Appeals and Interferences ("Board") has made it clear that Japikse should be limited to the facts of that particular case (i.e., missing subject matter relating to the position of a starting switch is immaterial and the overall operation of the device at issue in the Japikse case would not be affected by the position change). Ex parte Robles, 1997 WL 1883840 (Bd. Pat. App. & Interf.). Moreover, the Board has expressly rejected application of Japikse as a per se rule of obviousness and held that reliance on Japikse to establish obviousness under 35

U.S.C. § 103(a), without supplying a factual basis, is improper. See Ex parte Makutonin, 2003 WL 23014547 (Bd. Pat. App. & Interf.).

In this case, the Office Action did not provide any factual basis or otherwise sufficient reasoning to support its allegation that rearranging the position of channels 19 of Simpson involves only routine skill in the art. In fact, the Office Action did not even carry out the prerequisite analysis (i.e., comparing the facts of the present case to those of Japikse) to determine whether any alleged holding in Japikse is even applicable in this case. Absent any such factual basis, as discussed above, the Office Action's mere reliance on Japikse to establish obviousness under 35 U.S.C. § 103(a) is improper and clearly erroneous.

In addition, contrary to the Office Action's allegation, rearranging the position of channels would not have been obvious to one of ordinary skilled in the art because, among other reasons, rearranging the position in the manner alleged by the Office Action would materially alter the overall operation of the Simpson device. For example, Simpson expressly teaches that the channels 19 are open at their front sides. See, e.g., Page 2, lines 29-30. These channels 19, forming spoon-shaped cross-sections, are used to remove dandruff (or other substances) from the roots of the hair and the scalp while the device is used substantially the same as an ordinary comb. See, e.g., page 2, lines 20-29 and 71-96. That is, while the device is used in an ordinary combing action (e.g., brushing in the forward direction perpendicular to a side of the device), channels 19 facing the same forward direction raise and carry dandruff from the scalp. If, however, channels 19 of Simpson were modified to face a direction of adjacent teeth, as alleged by the Office Action, channels 19 would more than likely not be able to

remove dandruff from the scalp in an ordinary brushing action, thereby necessarily destroying the express teachings of Simpson. Therefore, rearranging the position of channels 19 of Simpson would not have been obvious to one of ordinary skill in the art.

For at least the reasons set forth above, the Office Action's rejection under 35 U.S.C. § 103(a) based on the alleged combination of Di Vito and Simpson is erroneous, and each of independent claims 1, 24, 39, 62, 84, 91, and 105 patentably distinguishes from the cited references. Therefore, reconsideration and withdrawal of this rejection under 35 U.S.C. § 103(a) is respectfully requested.

Claims 3, 7, 8, 41, 45, 46, 64, 66, and 67 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Di Vito in view of Simpson, and further in view of U.S. Patent No. 1,180,199 to Smith ("Smith"). Dependent claims 3, 7, and 8 depend from independent claim 1, dependent claims 41, 45, and 46 depend from independent claim 39, and dependent claims 64, 66, and 67 depend from independent claim 62. Smith does not supply all of the deficiencies of Di Vito and Simpson. Therefore, these dependent claims also patentably distinguish from the cited references at least by virtue of their respective dependencies from independent claims 1, 33, or 62.

In view of the foregoing Remarks, Applicants respectfully request reconsideration of this application, withdrawal of all of the outstanding rejections, and allowance of all pending claims.

The Office Action contains a number of statements and characterizations regarding the claims and the related art. Applicants decline to subscribe automatically to any statement or characterization in the Office Action, regardless of whether it is addressed above.

Should the Examiner wish to discuss this case, he is invited to call the undersigned at 517-203-2774.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: January 5, 2007

By: Anthony M. Gutowski (Reg. No. 50,585)
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